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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,494	11/19/2003	Kazuo Okada	245550US2	5961
22850	7590	11/17/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			HSU, RYAN	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,494

Applicant(s)

OKADA, KAZUO

Examiner

Ryan Hsu

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/19/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/19/03; 9/1/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-7 and claims 1-10 of copending Application No. 10/697,238 and 10/697,027. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed towards a gaming machine that comprises a variable display device that displays designs or symbols. Additionally, they include a front electric display which consist from a group of at least a liquid crystal display panel or series of light emitting diodes. This display uses a light guiding plate to create an illuminating effect for the display device so that a gaming machine can produce several different array of symbols and designs that compliment the basic reel display

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device commonly found in game machines. The two sets of claims have simply been rearranged so that they are claimed in different orders and are directed towards the same device except one uses a light emitting diode and the other a liquid crystal display. However, these are different forms of lighting display devices and perform the same function therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use either type of lighting device to perform the same functions as described in the claims. Therefore it would be obvious that these two inventions are not patentably distinct but simply have used alternative synonyms and language structure to detail the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Loose et al. (EP 1,260,928 A2).

Regarding claim 1, Loose et al. discloses a variable display unit for variably displaying a plurality of symbols (*see mechanical reels [12(a-c)] of Fig. 1 and the related description thereof*); a selector for selecting a winning combination (*see microcontroller [30] of Fig. 1 and the related description thereof*); and an electrical display provided above the variable display unit (*see display [18] and secondary display [40] of Fig. 1*).

Regarding claim 2, Loose et al. discloses a gaming machine comprising a translucent electrical display provided in front of the variable display unit (*see transmissive display [16] of Fig. 2a and the related description thereof*).

Regarding claim 3, Loose et al. discloses a game controller for generating a special game state which gives an advantage to a player a player based on a predetermined condition (*see bonus game of Fig. 7 and the related description thereof*); wherein the translucent electrical display executes shielding control for making at least part of the variable display unit invisible to the player during the special game state, based on a prescribed condition (*see Fig. 8a and the related description thereof*).

Regarding claims 4-5, Loose et al. discloses a game machine wherein the electrical display displays a pay table in which the winning combination is associated with a predetermined prize to be awarded when the winning combination is formed (*see Fig. 5 and the related description thereof*). Additionally, Loose discloses a switch for switching the pay table to another table (*see Fig. 5 and the related description thereof*).

Regarding claim 6, Loose et al. discloses a game machine wherein the electrical display displays an image for decorating the gaming machine (*see Fig. 8c and the related description thereof*).

Regarding claim 7, Loose et al. discloses a game machine wherein the translucent electrical display displays an image according to a game state while executing the shielding control (*see Figs. 10(b-c) and the related description thereof*).

Regarding claim 8, Loose discloses a game machine wherein the translucent electrical display executes the shielding control to indicate an advantageous way of operating the gaming

machine to the player (*ie: Wild symbol occurring for advantageous result for player*) (*see Fig. 9c and the related description thereof*).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takemoto et al. (US 5,472,195) – Display System at a Game Machine Island.

Takemoto (US 5,462,277) - Game Machine Having an Apparatus for Showing Prize Awarding Combinations on Rotating Drums.

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached at (571)-272-6788.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

RH

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A handwritten signature in cursive script that reads "Scott E. Jones".

SCOTT JONES
PRIMARY EXAMINER

November 8, 2006